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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,430	06/24/2003	David J. Nelson	01333	9642

7590 12/20/2005

Milton S. Sales  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/602,430

Applicant(s)

NELSON ET AL.

Examiner

Bruce H. Hess

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10-3-09 (Election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 4 and 6-8 is/are allowed.
- 6) ☒ Claim(s) 4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 5 and 9 is/are objected to.
- 8) ☐ Claim(s)        are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on        is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No.       .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 6-24-03 and 1-31-05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1774

The election of species is adhered to and made final for the reasons of record. This election will be withdrawn if applicants state on the record that species I-IV are not patentably distinct over each other.

Claims 4 and 6-8 are rejected under 35 USC 102 (a) as being anticipated by the patent to Jagannathan et al. (USP 6,471,327).

This patent teaches an article marked with a marking material which can have a particle size as small as 1 nanometer (see column 10, lines 3-5). Applicants' specification at page 18, lines 9-13, acknowledges that marking particles < 20 nanometers are nanocrystals which exhibit changes in properties that diverge from those in the bulk state. Consequently, it is inherent that the < 20 nanometer marking particles contemplated by Jagannathan et al. exhibit a measurable property non-characteristic of the same marking material in the bulk state.

Claims 4 and 6-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 20 of U.S. Patent No. 6,471,327. Although the conflicting claims are not identical, they are not patentably distinct from each other because marking particles from 1-20 nanometers in diameter inherently have a measurable property which is non-characteristic of the same marking material in the bulk state (see the previous paragraph).

Claims 5 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300